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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/540,533 | 07/19/2005 | Mark H. Shipton | 124323 | 3554 |

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| EXAMINER | |
|---|---|
| LAVILLA, MICHAEL E | |
| ART UNIT | PAPER NUMBER |
| 1775 | |

| MAIL DATE | DELIVERY MODE |
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| 09/27/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/540,533 | SHIPTON ET AL. | |
| | Examiner | Art Unit | |
| | Michael La Villa | 1775 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *30 July 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) *6-8 and 12-15* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 9-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20050624*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Group I in the reply filed on 30 July 2007 is acknowledged. The traversal is on two ground(s). Applicant argues that the claim groups are related by a common special technical feature. As well, applicant argues that searching all claims would not entail a serious examining burden. This is not found persuasive because the Restriction letter explained why the corresponding technical feature is not special since the corresponding technical feature is taught and/or suggested by the prior art. As well, prima facie evidence that searching all claim groups would constitute a serious burden is found in their separate classifications. Hence, Group I would be 428/670; Group II, 205/264; and Group III, 427/127.
2. The requirement is still deemed proper and is therefore made FINAL.
3. Claims 6-8 and 12-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 30 July 2007.

### *Claim Objections*

4. Claim 1 is objected to because of the following informalities: Regarding Claim 1, line 2, the word "therein" should read "wherein". Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1, 3, 4, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamamura et al. EP 0 361 308. Hamamura et al. teaches corrosion protective coating a RE-TM alloy with noble metal layer. See Hamamura et al. (Claims 1-14). Hamamura et al. suggests including Sm in the alloy and suggests coating with Pt. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a RE-TM alloy having Sm and an alloy coating of Pt since Hamamura et al. suggests that effective articles are made in this manner. It would have been obvious to one of ordinary skill in the art at the time of the invention to coat less than the entire surface of the magnet of Hamamura et al. where less than the entire surface will

be exposed to corrosive environment from which protection is required in an actual implemented use of a magnetic article incorporating the fabricated magnet of Hamamura et al.

8. Claims 1-5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. in "Surface reaction and Sm Depletion. . . " (cited by applicant in the IDS of 24 June 2005) in view of Hamamura et al. EP 0 361 308. Chen et al. teaches Sm-TM permanent magnets, including those claimed in Claim 2, that are coated. See Chen et al. (Abstract; page 2531, section I; page 2532, column 2, including Figure 5(a) and corresponding discussion). Chen et al. teaches the desirability of developing new coatings for these alloys, but does not teach coating the articles with platinum. Hamamura et al. teaches corrosion protective coating a RE-TM alloy with noble metal layer and suggests including Sm in the alloys and using Pt in the coating. See Hamamura et al. (Claims 1-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the alloy of Chen et al. with a corrosion protection coating such as described by Hamamura et al. in order to try established coatings that may be effective for the purpose of Chen et al., including the purpose of minimizing oxidation. It would have been obvious to one of ordinary skill in the art at the time of the invention to coat less than the entire surface of the magnet of Chen et al. where less than the entire surface will be exposed to high temperature environment from which protection is required in an actual implemented use of a magnetic article incorporating the fabricated magnet of Chen et al. It would have

been obvious to one of ordinary skill in the art at the time of the invention to use the articles of Chen et al. in an aerospace component exposed to high temperatures since aerospace engineers utilize these materials because they are suitable for high temperature.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael La Villa
18 September 2007

MICHAEL E. LAVILLA PH.D.
PRIMARY EXAMINER